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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/875,530      | 06/06/2001  | Hisashi Tanaka       | 14684               | 6951             |

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SCULLY SCOTT MURPHY & PRESSER, PC  
400 GARDEN CITY PLAZA  
GARDEN CITY, NY 11530

EXAMINER

POND, ROBERT M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3625

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/875,530

Applicant(s)

TANAKA ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-15,18-29 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-15,18-29 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant canceled Claims 5, 16, 17, and 30-33, and amended Claims 1-3, 6-12, 18-20, 26, 28, and 34. All pending claims (1-4, 6-15, 18-29, and 34-37) were examined in this final Office Action necessitated by amendment.

### ***Response to Arguments***

#### **Rejection under 35 USC 112**

The Applicant amended Claim 26 to overcome the rejection. Rejection under 35 USC 112 for Claim 26 is withdrawn.

#### **Rejection under 35 USC 102**

Applicant's arguments filed 07 September 2004 have been fully considered but they are not persuasive. Boesch discloses a customer registering in advance, the customer already being known to the system (please see at least Fig. 2A (212); col. 3, lines 43-45, 63-65). Boesch further discloses customer information comprising a plurality of items, at least one of the plurality of items alternative pieces of information provided by the user are displayed (e.g. consumer can change previously entered customer data, having a plurality of possible entries, optional information displayed to the customer) (please see at least col. 9, line 50 through col. 10, line 16).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1-4, 6-15, 18-29, and 34-37 are rejected under 35 USC 102(e) as being anticipated by Boesch et al. (Paper #2, patent number 6,092,053 hereinafter referred to as “Boesch”).**

Boesch teaches all the limitations of Claims 1-4, 6-15, 18-29, and 34-37. For example, Boesch discloses a method of electronic commerce allowing consumers to purchase items over a network and merchants to receive payment information relating to the purchases (please see at least abstract; Fig. 1 (100, 102, 120, 122, 160); col. 2, line 10 through col. 4, line 62). Boesch further discloses:

- Storing customer information entered in a plurality of terminals; in advance: customer registering in advance, the customer already being known to the system (see at least Fig. 2A (212); col. 2, line 66 through col. 3, line 19; col. 3, lines 43-45, 63-65; col. 7, lines 14-44).
- Designating a commodity provided by commodity provision means: merchant server, CIS, network (see at least col. 3, lines 20-54).

- Displaying the customer information; alternative pieces: displays graphic of customer wallet on customer computer via web browser (see at least col. 3, lines 37-43); customer information comprising a plurality of items, at least one of the plurality of items alternative pieces of information provided by the user are displayed; consumer can change previously entered customer data; having a plurality of possible entries; optional information displayed to the customer (see at least col. 9, line 50 through col. 10, line 16).
- Customer information pertaining to the designated commodity: e.g. credit card number, address, shipping address (see at least col. 3, lines 54-61).
- Storing; storage means: databases, data logs, data structures (see at least col. 3, lines 18-19; col. 12, lines 16-18).
- Modules: software, pages, forms (please note examiner's interpretation: pages and forms are examples of display modularity as executed by software) (see at least col. 3, line 62-65).

Pertaining to system Claims 12-15, 18-29, and 34-37

Rejection of Claims 12-15, 18-29, and 34-37 is rejected based on the same rationale as noted above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:


***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

703-872-9306 (Official communications; including After Final  
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', with a stylized, flowing script.

Robert M. Pond  
Primary Patent Examiner  
December 23, 2004